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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,431	06/29/2001	Richard Qian	42390P11146	8957

7590 01/17/2006

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EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2161

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/895,431	<b>Applicant(s)</b> QIAN, RICHARD	
	<b>Examiner</b> Susan Y. Chen	<b>Art Unit</b> 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 90-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 90-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/20/2005 has been entered.

This office action is in response to the amendment filed on 7/20/2005, wherein, there is a typo at page 2, line 3 of instant amendment, claims that have been canceled should be changed to 1-86, instead of 1-99. Furthermore, the numbering of newly added claims 90-105 is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 90-94 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 90, the claimed subject matter "a flash memory of the smart card" and "a template database stored in the flash memory" are new, because they are not disclosed by the original filed specification.

As to claims 91-94, these claims have the same defect as their base claim, hence are rejected for the same reason.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 90-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr (U.S. Patent No. 6,386,451) in view of Sezan et al. (U.S. Patent No. 6,236,395).

As to claims 90, 95 and 104, Sehr discloses an apparatus comprising:

a portable medium such as a smart card with embedded microprocessor (or logic circuit of the portable medium) and memory to store user's preferences [e.g., Abstract, lines 1-10; the multi-application smart card 11, col. 6, lines 19-54; Fig. 1 and associated texts; claim 2];

a template database stored in the memory that including a plurality of user preference templates that each correspond to a different electronic device [e.g., the distributed database 10, 20, 30 of Fig. 1 and the passenger card database processing, col. 5, lines 14-51; col. 6, lines 19-54].

a machine-readable medium of the portable medium [e.g. the smart card, col. 6, lines 19-20].

Sehr did not specifically discloses the claimed first user preference template is compatible with a television and the second user preference template is compatible with a computer having a web browser.

However, Sezan et al. (hereinafter referred as Sezan) discloses an audiovisual data management system [e.g., the unit 16, Fig. 1] with the claimed features, comprising: An audiovisual program analysis modules [e.g., the unit 42,

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Fig. 2] coupled to a data storage unit [e.g., the data storage unit 50, Fig. 2] that stores a plurality of user preference templates identified by user description scheme [e.g., the unit 20, Fig. 1 and associated texts], wherein the user description scheme, system description scheme and program description schema are configured to allow a portable medium [e.g., a smart card, col. 6, line 6] to communicate with a plurality of devices that correspond to various templates including the claimed compatible television and a web browser templates as recited by applicant via use's preference information stored in the schemes [e.g., Fig(s). 1-12 and associated texts; col. 5, lines 37 – col. 6, line 20, col. 9, lines 1-25; col. 9, line 34 – col. 10, line 56].

Sehr and Sezan are in the same field of endeavor to optimize the portable device such as smart card processing, therefore, with the teachings of Sehr and Sezan in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the well known technique as disclosed by Sezan into Sehr portable device processing system, because by doing so as suggested by Sezan, the combined will be upgraded to use a combination of the description schemes to enhance its ability to search, filter and browse audiovisual information in a personalized and effective manner for different devices with different templates [e.g., Sezan: col. 45, lines 45 – 67].

As to claims 91-92, 97-98 and 103, except the features disclosed on claims 90 and 95, the combined system further discloses the template database

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having stored usage history information for prioritizing user preference [e.g., col. 5, lines 3-6; lines 59-66].

As to claims 93 and 99, except the features disclosed on claims 90 and 95, the combined system further discloses the user preference data is stored in an extensible markup language format [e.g., Sezan: the web pages information format, col. 5, lines 22-32].

As to claims 94 and 96, except the features disclosed on claims 90 and 95, the combined system further discloses the system having logic circuit to dynamically update the user preference information based on user activity [e.g., Sezan: col. 5, lines 66 – col. 6, line 12].

As to claims 100-102, except the features disclosed on claims 90 and 95, the combined system further discloses the instruction stored on the machine-readable medium database cause a microprocessor of the portable medium generating a template via an identification template [e.g., Sehr: col. 17, lines 7-45].

As to claim 105, except the features disclosed on claims 90 and 95, the combined system further discloses the machine-readable medium having flash memory [e.g., Sehr: the memory of claim 2, col. 45].

***Response to Amendment***

Applicant's arguments with respect to claims 99-105 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Minne (U.S. Patent No. 6,762,930) which discloses an electronic device with on-card intelligent controller to communicate the form factor of the card to a host device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax



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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen  
Examiner  
Art Unit 2161

December 20, 2005

  
**UYEN LE**  
**PRIMARY EXAMINER**